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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER

ZHANG, FAN

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/815,614	Applicant(s) LAPSTUN ET AL.	
	Examiner FAN ZHANG	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 8, 11, 14, 15, 17, 20, 27-29, 32-36, 41, and 47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims withdrawn from consideration are 5-7,9,10,12,13,16,18,19,21-26,30,31,37-40,42-46 and 48.

DETAILED ACTION

Response to Arguments

1. Applicants' arguments received on May 18, 2008 with respect to amended independent claims 1, 27, and 47 have been fully considered but they are not persuasive, and with respect to amended dependent claims 15 and 36, they are moot in view of new grounds of rejection.

With respect to the validity of prior art from Lubow et al (US Pub: 2006/0118631), Applicants argue that "Lubow has a publication date of June 8, 2006, which is well after the filing date of the present application (April 2, 2004). Lubow is thus not available as prior art against the present application". Examiner respectfully disagrees. The original rejection made under U.S.C. 103(a) in view of Lubow et al utilizes the PCT filing date, Oct 25, 2002, which is a valid 102(e) date since it was an international application filed after Nov 29, 2000, designated the United States, and was published by WIPO under the PCT Article 21(2) in the English language. See MPEP 2136 [R-3] and 706.02(a) [R-3] / B. 35 U.S.C. 102(e) for details.

With respect to dependent claim 15, Applicants' amendments introduce further limitations, which render the corresponding arguments moot points in view of new ground of rejection.

With respect to amended independent claims 1, 27, and 47, the applicants argue that "Lubow fails to teach or suggest printing a code on multi data portions, with the code as printed on each portion is indicative of an identify of the product item, such that the product item is distinguished from each other product item. The code of Lubow is

the same for all product items in the same batch". Lubow clearly prescribes that "the first bar code indicia may designate a product identifier such as a specific drug, while the second bar code indicia identifies a commodity number, in which case the information is analyzed to determine if the commodity number is known to be associated with the particular drug". Although it may have been suggested in Lubow's teaching that the bar codes are the same for all product items in the same batch, but different between those in one batch and another, as argued by Applicants, Lubow still anticipates the amended claim: "the product identity data being indicative of an identity of the product item, such that the product item is distinguished from each other product item", as the claim fails to specify the relative relationship and location between two product items that are distinguished from each other. In other words, Examiner interprets the claim language as one product item in batch #1 has product identity data different from that of an item in batch #2.

With respect to other dependent claims, either the original ground of rejection stands or new ground of rejection is introduced due to further amended limitations.

Response to Amendment

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 (e) that forms the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 1, 2, 4, 14, 27, 28, 33, 35, and 47 are rejected under 35 U.S.C. 102 (e) as being anticipated by Lubow et al (Pub No.: US 2006/0118631).

Regarding claim 1 (currently amended), Lubow et al teach: A method of printing an interface surface associated with a product item, the method including the steps of: (a) determining product identity data, the product identity data being indicative of an identity of the product item such that the product item is distinguished from each other product item [p0017]; and, (b) controlling a printer to thereby print a plurality of coded data portions on the interface surface, the data of each coded data portion being indicative of the product identity data [p0086, p0087].

Regarding claim 2 (currently amended), Lubow et al further teach: the method of claim 1, wherein the determining step includes the sub-steps of: receiving indicating data at least partially indicative of the identity of the product items; and, generating, using the indicating data, the product identity data [p0047].

Regarding claim 4 (currently amended), Lubow et al further teach: The method of claim 1, wherein at least one of the product item and the interface surface is

associated with a barcode, and the determining step includes sensing the barcode to determine the product identity data [p0087].

Regarding claim 14 (currently amended), Lubow et al further teach: The method of claim 1, wherein the determining step includes the sub-steps of: determining an identifier indicative of a nature of the product item [p0087: lines 15-17]; generating a serial number [p0087: lines 17-20. A serial number can be a commodity number.]; and forming the product identity data from the identifier and the serial number [p0086: lines 23-32]

Claim 27 (currently amended) has been analyzed and rejected w/r to claim 1 in accordance with Lubow et al's further teaching on: a printer for printing an interface surface associated with a product item [fig. 2, unit 145].

Claim 28 (currently amended) has been analyzed and rejected w/r to claim 2 in accordance with the rejection of claim 27 and Lubow et al's further teaching on: a computer system communicates with the printer [fig. 2, unit 120].

Regarding claim 33, Lubow et al further teach: The printer of claim 27, wherein at least one of the product item and the interface surface is associated with a barcode,

the printer being adapted to sense the barcode to determine the product identity data [p0038].

Regarding claim 35 (currently amended), Lubow et al further teach: The printer of claim 27, wherein the printer is further adapted to encode the product identity data by printing a barcode on the interface surface or the product item [p0086, p0087].

Claim 47 (currently amended) has been analyzed and rejected w/r to claims 27 and 28.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3, 8, 17, 32, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lubow et al (Pub No.: US 2006/0118631) and in further view of Kirkham (Pub No.: US 2002/0067267).

Regarding claims 3 and 8 (currently amended), Lubow et al do not teach an RFID tag. In the same field of endeavor, Kirkham teaches: The method of claim 1, wherein at least one of the product item and the interface surface is associated with an

RFID tag, and the determining step includes reading the RFID tag to determine the product identity data, and encoding the product identity data in an RFID tag associated with the product item [p0056]. Using RFID tags for product identification has been well known and practiced in the art as prescribed by Kirkham. Therefore, it would have been an obvious variation for an ordinary skilled in the art to substitute RFID tag for Lubow's barcode for offering a better range and stronger signal for scanning operation.

Regarding claim 17 (currently amended), Lubow et al do not specify an EPC associated with the product item. Since EPC (Electronic Product Code) is a type of application of RFID technology, Kirkham further teaches: the method of claim 1, wherein the product identity data is indicative of an EPC associated with the product item [0042; 0043: lines 1-7]. Using RFID tags with EPC for product identification has been well known and practiced in the art as prescribed by Kirkham. Therefore, it would have been an obvious variation for an ordinary skilled in the art to substitute RFID tag with EPC for Lubow's barcode for offering a better range and stronger signal for product identification process.

Claim 32 (original) has been analyzed and rejected w/r to claim 3 in accordance with the rejection of claim 27.

Claim 34 (currently amended) has been analyzed and rejected w/r to claims 3 and 8 in accordance with the rejection of claim 27.

6. Claims 11 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lubow et al (Pub No.: US 2006/0118631) and in further view of Saito (Pub No.: US 2003/0201325).

Regarding claim 11 (currently amended), Lubow et al do not teach infrared ink. In the same field of endeavor, Saito teaches: The method of any one of claim 1, wherein the coded data portions are printed in infrared ink [p0069]. Therefore, it would have been obvious for an ordinary skilled in the art to modify Lubow et al's teaching to use infrared ink for security purpose.

Claim 29 (original) has been analyzed and rejected w/r to claim 11 in accordance with the rejection of claim 27.

7. Claims 20 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lubow et al (Pub No.: US 2006/0118631) and in further view of Endoh (Patent No.: 5,818,031).

Regarding claim 20, Lubow et al teach redundant barcodes in [p0042, lines 9-14]. However, Lubow et al do not teach encoding a bar code using Reed-Solomon code. In the same field of endeavor, Endoh teaches: The method of claim 1, wherein the coded data portions are encoded using Reed-Solomon encoding [col 2, lines 56-64]. Therefore, it would have been obvious to an ordinary skilled in the art to combine Lubow

et al and Endoh's teaching to redundantly encode bar codes with Reed-Solomon code for improving the probability of reading the bar codes printed on mails as prescribed by Endoh.

Claim 41 (currently amended) has been analyzed and rejected w/r to claim 20 in accordance with the rejection of claim 27.

8. Claims 15 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lubow et al (Pub No.: US 2006/0118631) and in further view of Kurokawa (US Patent: 5,625,467).

Regarding claim 15 (currently amended), Lubow et al do not have coded data indicative of the respective position of the coded data. In the same field of endeavor, Kurokawa teaches: The method of claim 1 wherein the data of each coded data portion is further indicative of the respective positions of the coded data portions on the interface surface [col 10: lines 46-55, col 13: lines 31-37]. Having a coded data indicative of the respective position of the code has been well practiced in the art as prescribed by Kurokawa. Therefore, it would have been obvious for an ordinary skilled in the art to modify Lubow et al's teaching to incorporate the position information as part of coded data for forming a composite bar code by precisely printing a second code next to a first one whose relative position can be obtained by scanning itself.

Claim 36 (currently amended) has been analyzed and rejected w/r to claim 15 in accordance with the rejection of claim 27.

9. Claims 5-7, 9, 10, 12, 13, 16, 18, 19, 21-26, 30, 31, 37-40, 42-46, and 48 are cancelled.

Conclusion

10. Applicant's amendment necessitated the new grounds of rejection presented in this Office Action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Contact

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fan Zhang whose telephone number is (571) 270-3751. The examiner can normally be reached on Mon-Fri from 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark K. Zimmerman can be reached on (571) 272-7653. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Fan Zhang/

Patent Examiner

/Mark K Zimmerman/

Supervisory Patent Examiner, Art Unit 2625